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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,481	11/28/2000	Ross G. Clark	P1071P1D15	7564
25213	7590	04/19/2004	EXAMINER	
HELLER EHRMAN WHITE & MCAULIFFE LLP 275 MIDDLEFIELD ROAD MENLO PARK, CA 94025-3506			ROMEO, DAVID S	
			ART UNIT	PAPER NUMBER

1647

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/724,481

### Applicant(s)

CLARK ET AL.

### Examiner

David S Romeo

### Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

The amendment filed 12/24/2003 has been entered. Claims 1 and 2 are pending.

**Maintained Formal Matters, Objections, and/or Rejections:**

5 ***Claim Rejections - 35 USC § 112***

Claims 1, 2 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are presumably: addition of the serially diluted phagemid clone.

10 The process steps in the claimed method comprise the following three steps:

1. incubating a phagemid clone, a polypeptide, and a ligand;
2. serially diluting the phagemid clone; and,
3. measuring the degree to which binding of the phagemid clone to the ligand

15 is inhibited by the peptide displayed on said phagemid clone, wherein the phagemid clone that is inhibited only at low phagemid concentrations has a higher affinity for the ligand than a phagemid clone that is inhibited at both high and low phagemid concentrations.

Claim 1, lines 6-7, recites the limitation “measuring the degree to which binding of the phagemid clone to the ligand is inhibited by the peptide displayed on said

20 phagemid clone.” See step 3, above. This limitation is directed to measuring the degree to which binding of the phagemid clone to the ligand is inhibited by the phagemid clone. However, it is unclear how binding of the phagemid clone to the ligand is inhibited by the

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phagemid clone and how this inhibition is measured when, according to claimed method, only a phagemid clone, a polypeptide, and a ligand are present. See step 1, above.

Claim 1, lines 7-9, recites the limitation “wherein the phagemid clone that is inhibited only at low phagemid concentrations has a higher affinity for the ligand than a phagemid clone that is inhibited at both high and low phagemid concentrations.” See step 3, above. This limitation is presumably directed to measuring the binding of the phagemid clone to the ligand at high and low phagemid concentrations. However, there is no earlier provision in the claimed method for incubating a phagemid clone, a polypeptide, and a ligand at high and low phagemid concentrations.

Claim 1, lines 5-6, recites the limitation “serially diluting the phagemid clone.” See step 2, above. However, the connection of this step with either step 1 or step 3, above, is unclear.

The metes and bounds are not clearly set forth.

Applicants argue that the amendment makes it clear that the peptide displayed by the phagemid clone competes with polypeptide. Applicant's arguments have been fully considered but they are not persuasive. Although Applicants' amendment helps in alleviating problems with the antecedent basis for the terms in the claims, the amendment does not address the issues in the present rejection.

Claims 1 and 2 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

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Applicants' argue that the premise underlying this rejection is incorrect.

Applicant's arguments have been fully considered but they are not persuasive. It doesn't matter whether the "phage" is the same as or different from the "phagemid." In either case, it would be impossible for the "phage" to inhibit "only at low phagemid concentrations" and not at higher phagemid concentrations.

### *Conclusion*

No claims are allowable.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO DAVID S. ROMEO WHOSE TELEPHONE NUMBER IS (571) 272-0890. THE EXAMINER CAN NORMALLY BE REACHED ON MONDAY THROUGH FRIDAY FROM 7:30 A.M. TO 4:00 P.M. IF ATTEMPTS TO REACH THE EXAMINER BY TELEPHONE ARE UNSUCCESSFUL, THE EXAMINER'S SUPERVISOR, GARY KUNZ, CAN BE REACHED ON (571) 272-0887.

IF SUBMITTING OFFICIAL CORRESPONDENCE BY FAX, APPLICANTS ARE ENCOURAGED TO SUBMIT OFFICIAL CORRESPONDENCE TO THE FOLLOWING TC 1600 BEFORE AND AFTER FINAL RIGHTFAX NUMBERS:

BEFORE FINAL (703) 872-9306  
AFTER FINAL (703) 872-9307

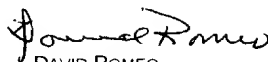
CUSTOMERS ARE ALSO ADVISED TO USE CERTIFICATE OF FACSIMILE PROCEDURES WHEN SUBMITTING A REPLY TO A NON-FINAL OR FINAL OFFICE ACTION BY FACSIMILE (SEE 37 CFR 1.6 AND 1.8).

FAXED DRAFT OR INFORMAL COMMUNICATIONS SHOULD BE DIRECTED TO THE EXAMINER AT (571) 273-0890.

ANY INQUIRY OF A GENERAL NATURE OR RELATING TO THE STATUS OF THIS APPLICATION OR PROCEEDING SHOULD BE DIRECTED TO THE GROUP RECEPTIONIST WHOSE TELEPHONE NUMBER IS (703) 308-0196.

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DAVID ROMEO  
PRIMARY EXAMINER  
ART UNIT 1647

DSR  
APRIL 15, 2004

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